

REMARKS

Upon entry of this Amendment, claims 23-42 will remain pending and under current examination. Applicants respectfully request reconsideration of this application in view of the following remarks.

I. Regarding the Non-Final Office Action

In the Office Action¹, the Examiner rejected claims 23-25, 32, and 33 under nonstatutory double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,629,107 to Ouchi et al. ("*Ouchi*") in view of U.S. Patent No. 5,894,306 to Ichimura ("*Ichimura*"); rejected claims 34-36 under nonstatutory double patenting as being unpatentable over claims 3-5 of *Ouchi* in view of *Ichimura*, and further in view of U.S. Patent Application Publication No. 2002/0085759 to Davies et al. ("*Davies*"); rejected claims 23, 24, and 37-42 under 35 U.S.C. § 103(a) as being unpatentable over *Ichimura* in view of *Davies*, and further in view of U.S. Patent No. 6,363,380 to Dimitrova ("*Dimitrova*"); and rejected claims 25-31 under 35 U.S.C. § 103(a) as being unpatentable over *Ichimura* in view of *Davies*, and further in view of *Dimitrova* and U.S. Patent No. 5,761,340 to Suzuki ("*Suzuki*").

Applicants amend claims 23, 41, and 42 to recite, in part, "a display comprising ... characters," subject matter of previously presented claim 26. Applicants also amend claims 25, 26, and 28 to more appropriately define the scope of the invention. In particular, claim 24 has been amended to further define the "plurality of attribute items."

Applicants also amend claim 25 to improve form or grammar and not for reasons related to patentability, and Applicants amend claim 27 to maintain antecedent basis.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

II. Regarding the rejections of claims 23-25, 32, and 33 under nonstatutory double patenting as being unpatentable over claim 9 of *Ouchi* in view of *Ichimura*; and regarding the rejection of claims 34-36 under non-statutory double patenting as being unpatentable over claims 3-5 of *Ouchi* in view of *Ichimura*, and further in view of *Davies*

Applicants respectfully traverse the nonstatutory double patenting rejection of claims 23-25, 32, and 33 on the grounds that the Examiner has failed to establish that the claims define an obvious variation of the invention defined in claim 9 of *Ouchi* in view of *Ichimura*.

Applicants also respectfully traverse the nonstatutory double patenting rejection of claims 34-36 on the grounds that the Examiner has failed to establish that the claims define an obvious variation of the invention defined in claims 3-5 of *Ouchi* in view of *Ichimura*, and further in view of *Davies*.

The Examiner did not reject claim 26 under double-patenting and thus apparently concedes that the subject matter of claim 26 is patentable distinct over the proposed combination of claim 9 or claims 3-5 of *Ouchi* in view of *Ichimura*. As noted above, such subject matter has been incorporated into claim 23, and thus Applicants submit that claim 23, as amended, is also patentably distinct over claim 3-5 and 9 of *Ouchi* and *Ichimura*. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the double patenting rejection of claim 23, as well as claims 24, 25, 32, and 33, which depend therefrom.

Davies fails to make up for the deficiencies of *Ouchi* in view of *Ichimura*. *Davies* is relied upon for allegedly teaching “an information recognition unit configured to recognize characters in an image and to extract a person’s name from the recognition result” (Office Action at p. 4). Such teachings, however, even if present, fail to overcome the deficiencies of *Ouchi* in view of *Ichimura* discussed above. Claims 34-36 are therefore patentably distinct over claims 3-5 of *Ouchi* in view of *Ichimura*, and further in

view of *Davies* at least due to their dependence from claim 25. Accordingly, Applicants respectfully request that the rejection of claim 34-36 under nonstatutory double patenting be withdrawn.

Additionally, Applicants note that the nonstatutory double patenting rejection is the only issue with respect to claims 34-36. Because this rejection has been overcome, claims 34-36 are deemed to recite allowable subject matter.

III. Regarding the rejection of claims 23, 24, and 37-42 under 35 U.S.C. § 103(a) as being unpatentable over *Ichimura* in view of *Davies*, and further in view of *Dimitrova*; and regarding the rejection of claims 25-31 under 35 U.S.C. § 103(a) as being unpatentable over *Ichimura* in view of *Davies*, and further in view of *Dimitrova* and *Suzuki*

Applicants respectfully requests that the Examiner reconsider and withdraw the rejection of claims 23-31 and 37-42 because a *prima facie* case of obviousness has not been established with respect to claims 23-31 and 37-42.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Ichimura*, *Davies*, *Dimitrova*, nor *Suzuki*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

In rejecting claim 26, the Examiner apparently concedes that *Ichimura* and *Dimitrova* fail to teach or suggest "a display configured to output the image and an attribute selection window

including a plurality of attribute items of characters,” as recited in previously presented claim 26. Accordingly, *Ichimura* and *Dimitrova* fails to teach “a display ...” as recited in amended claim 23.

In rejected previously presented claim 26, however, the Examiner relies on *Suzuki* and *Davies* for allegedly disclosing “a display configured to output the image” and “an information recognition unit having a plurality of knowledge dictionaries.”

In particular, the Examiner asserts that Figs. 7-11 of *Suzuki* teaches edit commands which meets the claimed display that presents “an attribute selection window including a plurality of attribute items” (Office Action at p. 11). Applicant notes that amended claim 23 further recites that each of the “attribute items” correspond to knowledge dictionaries. However, the Examiner does not rely on *Suzuki* for teaching or suggesting “an information recognition unit having a plurality of knowledge dictionaries each corresponding to each of the plurality of attribute items,” as recited in amended claim 23 (Office Action at p. 11).

Moreover, as seen in FIG. 9 of *Suzuki*, the editing commands are previously registered. According to *Suzuki*, when a key figure is drawn corresponding to a desired editing command, the desired editing is selectively executed (*Suzuki*, FIG. 9 and 10). Such teachings of drawing an editing command do not constitute a teaching or suggestion of

a display configured to output the image and an attribute selection window including a plurality of attribute items of characters;

an information recognition unit having a plurality of knowledge dictionaries each corresponding to each of the plurality of attribute items, configured to select one attribute item from the plurality of attribute items in response to a user’s indication, to recognize characters in the image by using one of the plurality of knowledge dictionaries corresponding to the one attribute item, to extract personal data from the recognition result of the characters, and to identify a speaker from the speech;

Suzuki does not teach or suggest at least presenting “attribute items of characters,” as claimed. Furthermore, *Suzuki* certainly does not teach or suggest “an information recognition unit having a plurality of knowledge dictionaries each corresponding to each of the plurality of attribute items,” as required by claims 25-31.

The Examiner, however, asserts a “display presents an attribute selection window ... [in] Davies: See Figs 4-5 including a plurality of attribute items ... [in] Davies: ‘stickers’” (Office Action at p. 11). Applicant disagrees with the Examiner’s assertion. *Davies* teaches scanning a business card to create a user ID and scanning documents to locate a sticker (*Davies*, paragraph 0014 and Fig. 5, items 510 and 512). Such teachings do not constitute a teaching or suggestion of “a display configured to output the image and an attribute selection window including a plurality of attribute items of characters,” as recited by amended claim 23.

Davies further teaches “applying a sticker to the document and placing it in to a bin to be scanned” (*Davies*, paragraph 0012) and further that this “does not require the user to enter commands” (emphasis added, *Davies*, paragraph 0017). Thus, *Davies* teaches away from an “attribute selection window ... [and] select[ing] one attribute item ... in response to a user’s indication,” as recited by amended claim 23.

Moreover, the Examiner alleges that *Davies* teaches “services (See 414 & 516-518)” (Office Action at p. 11). However, the services in *Davies*, include, for example, “‘scan and send via e-mail,’ ‘scan and fax,’ ‘scan and print,’ and so forth” (*Davies*, paragraph 38). Such services do not constitute a teaching or suggestion of “an information recognition unit having a plurality of knowledge dictionaries each corresponding to each of the plurality of attribute items,” (emphasis added) as recited by amended claim 23.

Because *Ichimura*, *Davies*, *Dimitrova*, and *Suzuki*, taken alone or in combination, fail to teach or suggest each and every element of claim 23, no *prima facie* case of obviousness has been made with respect to this claim. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over *Ichimura* in view of *Davies*, and further in view of *Dimitrova* and *Suzuki*.

Claims 24-31 and 37-39 depend from claim 23 and therefore including all of the elements recited therein. Claims 24-31 and 37-39 are thus allowable at least for the reasons discussed above regarding claim 23, and for additional distinctions recited therein. Accordingly, Applicants respectfully request the rejection of claims 24-31 and 37-39 under 35 U.S.C. § 103(a) be withdrawn.

Independent claims 41 and 42, although of different scope, recite elements similar to those of claim 23. Claims 41 and 42 are thus allowable at least for the reasons discussed above with respect to claim 23. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 41 and 42 as being unpatentable over *Ichimura* in view of *Davies*, and further in view of *Dimitrova*.

In addition, *prima facie* obviousness has not been established at least because the requisite motivation to modify the cited references is lacking. Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to modify a reference must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re*

Lee, 277 F.3d 1338, 1343-1344, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008).

In the rejection, the Examiner has not shown that one of ordinary skill in the art, when considering *Ichimura* in view of *Davies*, and further in view of *Dimitrova* and *Suzuki*, and not having the benefit of Applicants' disclosure, would have been motivated to modify *Ichimura* in view of *Davies*, and further in view of *Dimitrova* and *Suzuki* in a manner resulting in Applicant's claimed invention. The Examiner failed to provide any evidence of motivation to combine the cited references (Office Action at p. 11 referring to claim 26).

Applicant directs the Examiner's attention to M.P.E.P. § 2143.01, which makes clear that: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (citations omitted). Here, the Examiner does not show that the cited references suggest the desirability of the alleged combination. For at least this additional reason, Applicant respectfully requests the Examiner to withdraw the rejections under 35 U.S.C. § 103(a).

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this reply and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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